

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Pierluigi Pugliese

Serial No.: 10/693,470

Filed: October 24, 2003

For: SYSTEM AND METHOD FOR COLLECTING DEBUGGING AND
SYSTEM CRASH INFORMATION FROM A MOBILE PHONE

Grp./A.U.: 2617

Examiner: Dai Phuong Confirmation No.: 2561

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop Appeal Brief-Patents

I hereby certify that this correspondence is being electronically filed with United States Patent and trademark Office on:

August 28, 2006 (Date)

Elizabeth Schumacher
(Printed or typed name of person signing the certificate)
/Elizabeth Schumacher/
(Signature of the person signing the certificate)

ATTENTION: Board of Patent Appeals and Interferences

Sirs:

APPEAL BRIEF UNDER 37 C.F.R. §41.37

This is an appeal from a Final Rejection dated March 13, 2006, of Claims 1-25. The Appellants submit this Brief with the statutory fee of \$500.00 as set forth in 37 C.F.R. §41.20(b)(2), and hereby authorizes the Commissioner to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 08-2395.

This Brief contains these items under the following headings, and in the order set forth below in accordance with 37 C.F.R. §41.37(c)(1):

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. APPELLANT'S ARGUMENTS
- VIII. APPENDIX A - CLAIMS
- IX. APPENDIX B - EVIDENCE
- X. RELATED PROCEEDINGS APPENDIX

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is the Assignee, Agere Systems, Incorporated.

II. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

Claims 1-25 are pending in this application and have been rejected under 35 U.S.C. §103(a).

Each of the pending claims is being appealed.

IV. STATUS OF THE AMENDMENTS

The present Application was filed on October 24, 2003. In response to a first Examiner's Action mailed September 14, 2005, the Appellant filed a first Amendment on February 17, 2006. The Examiner entered the first Amendment and subsequently issued a Final Rejection on March 13, 2006. The Appellant then filed a Request for Reconsideration on May 12, 2006. In an Advisory Action mailed on June 30, 2006, the Examiner indicated that the Request for Reconsideration had been considered, but did not place the Application in condition for allowance. The Appellant then filed a Notice of Appeal on June 26, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed, in general, to a mobile communication apparatus. The present invention introduces a method and apparatus for collecting data on at least one of the individual components and procedures embedded within a mobile communication apparatus on a subscriber information module (SIM) card and transmitting such data from the mobile communication apparatus to a service center via an affiliated radio network.

Independent Claim 1 is directed to a method of ascertaining a state of a mobile communication apparatus. In one embodiment, a SIM card is used to collect data on at least one of the individual components and procedures embedded within a mobile communication apparatus, based on status quo information derived therefrom, and transmitted by radio to a service center via a radio network with which the mobile communication apparatus is affiliated. (Paragraphs 0026; 0028 – 0031; FIGURE 1).

Independent Claim 13 is directed to a mobile communication apparatus. In one embodiment, a SIM card is used to collect data on at least one of the individual components and procedures embedded within the mobile communication apparatus, based on status quo information derived therefrom, and transmitted, using a means for radio transmitting, from the mobile communication apparatus via a radio network, with which the mobile communication apparatus is affiliated, to a service center. (Paragraphs 0026; 0028 – 0031; FIGUREs 1 and 2).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The first issue presented for consideration in this appeal is whether Claims 1-25, as rejected by the Examiner, are patentably nonobvious under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 20010029263A1 filed by Xiang Zhang, in view of U.S. Patent Application Publication No. 20040075675A1 filed by Tommi Raivisto, *et al.* (Raivisto).

VII. APPELLANTS' ARGUMENT

The inventions set forth in independent Claims 1 and 13 and their respective dependent claims are neither anticipated by nor obvious within the meaning of 35 U.S.C. 103(a) over Zhang in view of Raivisto. As the Board is no doubt aware, a determination of obviousness requires consideration of the invention considered as a whole; the inquiry is not whether each element exists in the prior art, but whether the prior art made obvious the invention as a whole. Furthermore, there must be some suggestion or teaching in the art that would motivate one of ordinary skill in the art to arrive at the claimed invention; a reference that teaches away from a claimed invention strongly indicates nonobviousness.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure.

Zhang discloses a mobile station monitoring system that has a maintenance task module to accumulate performance data reported within a mobile station, a transmission conduit for transmitting accumulated performance data to a central location, and a central receiver at the central location that receives and deciphers the transmitted accumulated performance data. Zhang also describes the mobile station as having a maintenance task module that accumulates the reported performance data within the mobile station. (Abstract)

The Examiner in his Office Action dated March 13, 2006, stated that Zhang does not describe or disclose a method or apparatus for ascertaining the state of a mobile communication apparatus by using a SIM card for collecting data on at least one of the individual components and procedures embedded within the mobile communications apparatus. Yet in his Advisory Action, the Examiner, while not completely refuting the statement that "...Zhang does not describe or disclose a method or apparatus for ascertaining the state of a mobile communication apparatus by using a SIM card...", takes an inconsistent position by stating he does not agree with it, although he does not state why. (Advisory Action, page 2, paragraph 1). The Examiner also states that "... one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." (Advisory Action, page 2, paragraph 1). The Appellant respectfully calls the Board's attention to the fact that the Zhang reference is not being "attacked" individually by reiterating a statement made by the Examiner in his Office Action, but that it is only being "attacked" in combination with the other reference provided by the Examiner in an attempt to overcome the shortfall of Zhang. It was, and continues to be, the Appellant's position that neither reference teaches or suggests a method or apparatus for ascertaining the state of a mobile communication apparatus by using a SIM card for collecting data on at least one of the individual components and

procedures embedded within the mobile communications apparatus. In short, not only are all of the elements of the present invention not provided for in the cited references, but there is no suggestion or teaching in the art that would motivate one of ordinary skill in the art to arrive at the claimed invention by combining the two references.

Raivistio is entitled “Apparatus and Method for Accessing Services Via a Mobile Terminal” and is “...directed to a system, apparatus, and method for locating available information and services/applications via mobile terminals through the use of a service panel that is operable via the mobile terminal.” (Para. 0009). Raivisto describes a system for facilitating the provisioning of services and the execution of those services at mobile terminals and not to a method or apparatus for ascertaining the state of a mobile communication apparatus by using a SIM card for collecting data on at least one of the individual components and procedures embedded within the mobile terminals.

The Examiner states that Raivisto is in the same field of endeavor as Zhang. As previously pointed out to the Examiner, if this statement is intended to mean that the both Raivisto and Zhang address mobile phone systems and are thus in the same field of endeavor, then the Appellant agrees. Apparently, this is what the Examiner means based on language in the Advisory Action. (Page 2, paragraph 3). However, even if within the same broad field of endeavor, the prior art must teach or suggest the combination of references. In the present case, Raivisto and Zhang are not both directed to the problem of identifying, gathering data on and providing solutions for problems inherent in mobile phones. Thus, the Appellant does not agree that Raivisto and Zhang are in the same field of endeavor within the meaning of 35 U.S.C. 103(a) for the purpose of rejecting Claims 1 and 13 as being nonobvious. The main reason the Appellant does not believe Raivisto and Zhang are in the same field of endeavor is because they represent extremely different aspects of mobile phone

technology, which is a very broad field. In fact, the Examiner acknowledges that each addresses different aspects of this very broad field without giving any reason on why they should be combined, except for the circuitous argument that they are in the same field. (Advisory Action, Page 3, commencing at line 17).

Zhang addresses the identification of mobile phone problems, gathering data regarding the same and providing solutions to such problems. On the other hand, Raivisto addresses how a user of a mobile phone can use that device to gather data from the communications network. Stated differently, Zhang is concerned with the gathering of information about a mobile phone and delivering that information to the network while Raivisto addresses the providing of information to a user of a mobile phone about a network, after such information has been gathered. Thus, the Appellant disagrees with the Examiner's conclusion that Zhang and Raivisto are sufficiently analogous to be combined so as to support the rejection of Claims 1-25 under 35 U.S.C. §103(a).

It should also be noted that, although Raivisto mentions that a SIM card is used to collect data, the data collected does not address the state of the mobile communication apparatus using the SIM card. Raivisto contains neither a teaching nor a suggestion that a SIM card can be provisioned or programmed with a routine for collecting data on at least one individual component or procedure embedded within a mobile communication apparatus based on status quo information. The Appellant again notes that the inquiry is not whether each element exists in the prior art in order to support a rejection under 35 U.S.C. §103(a), but whether the prior art of Zhang and Raivisto made obvious the invention as a whole. The Appellant submits there is no suggestion or teaching in Zhang and Raivisto, taken together, that would motivate one of ordinary skill in the art to arrive at the claimed invention, much less enable the present invention. Thus, Zhang, individually or in

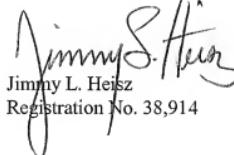
combination with Raivisto, fails to teach or suggest the invention recited in independent Claims 1 and 13.

It is Appellant's belief that Zhang, individually or in combination with Ravisto, fails to teach or suggest the invention recited in independent Claims 1 and 13. Because Claims 2-12 are ultimately dependent upon Claim 1 and Claims 14-25 are ultimately dependent on Claim 13, Zhang also does not render obvious Claims 2-12 and 14-25. Claims 1-25 are therefore not obvious in view of Zhang and Ravisto.

For the reasons set forth above, the Claims on appeal are not patentably nonobvious over Zhang in view of Ravisto. Accordingly, the Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's Final Rejection of all of the Appellant's pending claims.

Respectfully submitted,

HITT GAINES, P.C.



Jimmy L. Heisz
Registration No. 38,914

Dated: August 28, 2006

Hitt Gaines, P.C.
P.O. Box 832570
Richardson, Texas 75083-2570
(972) 480-8800
(972) 480-8865 (Fax)
Jimmy.heisz@hittgaines.com

VIII. APPENDIX A - CLAIMS

1. A method of ascertaining a state of a mobile communication apparatus, comprising:
collecting data on at least one of individual components and procedures embedded within said mobile communication apparatus, based on status quo information derived therefrom, on a subscriber information module (SIM) card; and
radio transmitting said data from said mobile communication apparatus via said radio network to which said mobile communication apparatus is affiliated to a service center.
2. The method as recited in Claim 1 wherein said collecting is performed by using a trace routine.
3. The method as recited in Claim 1 wherein said transmitting is performed by using a selected one of an SMS and a predefined data call.
4. The method as recited in Claim 1 wherein said data are coded in a space-efficient format prior to performing said radio transmitting.
5. The method as recited in Claim 1 wherein said data are stored prior to performing said radio transmitting.
6. The method as recited in Claim 1 wherein said radio transmitting is performed in regularly spaced intervals.
7. The method as recited in Claim 1 wherein said radio transmitting is performed during an initializing menu procedure.

8. The method as recited in Claim 7 wherein said menu procedure is activated during a selected one of when said mobile communication apparatus is logged-in to said network and when said mobile communication apparatus is logged-off from said network.

9. The method as recited in Claim 7 wherein said menu procedure is activated by a selected one of said user of said mobile communication apparatus and externally via said network.

10. The method as recited in Claim 1 wherein said data are transferred between said mobile communication apparatus and said network without signaling said user of said mobile communication apparatus.

11. The method as recited in Claim 1 wherein said data are weighted.

12. The method as recited in Claim 1 wherein a selected one of said collecting and said transmitting is carried out dependent on selectable information items.

13. A mobile communication apparatus, comprising:

a subscriber information module (SIM) card for use in said mobile communication apparatus, said SIM card having a means for collecting data on at least one of individual components and procedures embedded within said mobile communication apparatus based on status quo information derived therefrom; and

means for radio transmitting said data from said mobile communication apparatus via said radio network to which said mobile communication apparatus is affiliated to a service center.

14. The mobile communication apparatus as recited in Claim 13 wherein said means for collecting is a trace routine.
15. The mobile communication apparatus as recited in Claim 13 wherein said means for transmitting is a selected one of an SMS and a predefined data call.
16. The mobile communication apparatus as recited in Claim 13 wherein said data are coded in a space-efficient format prior to said radio transmitting.
17. The mobile communication apparatus as recited in Claim 13 wherein said data are stored prior to said radio transmitting.
18. The mobile communication apparatus as recited in Claim 13 wherein said radio transmitting is performed in regularly spaced intervals.
19. The mobile communication apparatus as recited in Claim 13 wherein said radio transmitting is performed during an initializing menu procedure.
20. The mobile communication apparatus as recited in Claim 19 wherein said menu procedure is activated during a selected one of when said mobile communication apparatus is logged-in to said network and when said mobile communication apparatus is logged-off from said network.
21. The mobile communication apparatus as recited in Claim 19 wherein said menu procedure is activated by a selected one of said user of said mobile communication apparatus and

externally via said network.

22. The mobile communication apparatus as recited in Claim 13 wherein said data are transferred between said mobile communication apparatus and said network without signaling said user of said mobile communication apparatus.

23. The mobile communication apparatus as recited in Claim 13 wherein said data are weighted.

24. The mobile communication apparatus as recited in Claim 13 wherein a selected one of said collecting and said transmitting is carried out dependent on selectable information items.

25. The mobile communication apparatus as recited in Claim 13 wherein said mobile communication apparatus is a mobile phone adapted to operate on a selected one of a GSM standard and a UMTS-standard.

IX. APPENDIX B - EVIDENCE

The evidence in this appendix includes the following, each of which was entered in the record by the Examiner with the March 13, 2006, Examiner' Office Action:

1. U.S. Patent Application Publication No. 20010029263 by Xiang Zhang.
2. U.S. Patent Application Publication No. 20040075675 by Tommi Raivisto, *et al.*

X. RELATED PROCEEDINGS APPENDIX

NONE